

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JEFFREY A. ROBL

Appeal No. 2001-1581
Application No. 08/833,172

ON BRIEF

MAILED

DEC 30 2002

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before WINTERS, ADAMS, and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the
examiner's final rejection of claims 1, 6, 7, and 12-14, which are all the claims
pending in the application.

Claim 1 is illustrative of the subject matter on appeal and is reproduced in
the Appendix of Claims attached to appellant's Brief.

The examiner does not rely on prior art.

GROUND OF REJECTION¹

Claims 1, 6, 7, and 12-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in the recitation of the term "cycloheteroalkyl".

Claims 1, 6, 7, and 12-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in the definition of "R", particularly the recitation of the phrase "R can be joined together with the carbon to which it is attached to form a 3 to 7 membered ring which may optionally be fused to a benzene ring" as it appears in the claimed invention.

We affirm.

CLAIM GROUPING

According to appellant (Brief, page 5), "[a]ll of the rejected [c]laims 1, 6, 7 and 12 to 14 stand or fall together." Since all claims stand or fall together, we limit our discussion to representative independent claim 1. Claims 6, 7 and 12-14 will stand or fall together with claim 1. In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991).

DISCUSSION

As set forth in Amgen Inc. v. Chugai Pharmaceutical Co., Ltd., 927 F.2d 1200, 1217, 18 USPQ2d 1016, 1030 (Fed. Cir. 1991):

The statute requires that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." A decision as to whether a claim is invalid under this provision requires a determination whether those skilled in the art

¹ We note that the issue regarding the "missing left parenthesis in claim 1" as set forth at page 3 of the Answer, was subsequently withdrawn. See Paper No. 19, mailed March 12, 2001.

would understand what is claimed. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985) (Claims must “reasonably apprise those skilled in the art” as to their scope and be “as precise as the subject matter permits.”).

Furthermore, claim language must be analyzed “not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art.” In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Cycloheteroalkyl:

According to the examiner (Answer, page 4), the term “‘cycloheteroalkyl’ is indefinite. It has no standard meaning, and is internally inconsistent. A cycloalkyl cannot have a heteroatom in the ring, because it would then no longer be a cycloalkyl.” In response, appellant argues (Brief, page 6), “[t]he term ‘cycloheteroalkyl’ is clearly well known to those skilled in the art prior to the filing dates of both the present application and its corresponding provision[al] application.” According to appellant (id), “cycloheteroalkyl is a saturated ring which includes at least one heteroatom.” In support of his position, appellant refers to several United States Patents. See Brief, pages 6-7.

However, as the examiner points out (Answer, page 4), appellant’s specification offers no evidence that a particular definition was intended for the term cycloheteroalkyl. In addition, with regard to the evidence relied upon by appellant, the examiner explains that two of the references provide no definition.

for the term, and the others fail to define the term cycloheteroalkyl as broadly as appellant asserts. See Id.

We appreciate that appellant is entitled, within reason, to be his own lexicographer. However, in the instant case, appellant failed to provide a definition of the term "cycloheteroalkyl" in his specification. Looking to the evidence relied upon by appellant to support his position, we agree with the examiner that the evidence fails to provide a consistent meaning of the term "cycloheteroalkyl" or even one that is as broad as appellant appears to have intended.

It may be that by reciting the term "cycloheteroalkyl" appellant intended to mean saturated heterocyclic rings, however, be that as it may the term as used in the claim is indefinite. Compare In re Morris, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997):

The appellants urge us to consult the specification and some of the cited prior art, including Brown, and interpret the disputed language more narrowly in view thereof. When read in light of this material, according to applicants, the "true" meaning of the phrase emerges. We decline to attempt to harmonize the applicants' interpretation with the application and prior art. Such an approach puts the burden in the wrong place. It is the applicants' burden to precisely define the invention, not the PTO's.

While the claims in Morris were not rejected on the ground of indefiniteness, the court explained that 35 U.S.C. § 112, second paragraph puts the burden of precise claim drafting squarely on the applicant. Id. The problem in this case, as in Morris², is that appellant failed to make the intended meaning explicitly clear.

² In re Morris, 127 F.3d at 1056, 44 USPQ2d at 1029.

second paragraph, as indefinite in the recitation of "cycloheteroalkyl." As set forth supra, claims 6, 7 and 12-14 will fall together with claim 1.

The definition of "R":

According to the examiner (Answer, page 5), "[t]he definition of R is unclear. R appears in the structural formula attached via a single bond [bond 1] to a carbon which also has attached to it a $-C(O)A$ group on the right [bond 2], the $HC(O)N(OR^{[1]})C_x-$ group on the left [bond 3], and a hydrogen [bond 4]." As the examiner explains (id.) the structural formula "clearly shows that R is monovalent. It has one bond to the carbon. The carbon already has four bonds." Therefore, the examiner finds (id.), the phrase "R can be joined together with the carbon to which it is attached to form a 3 to 7 membered ring which may optionally be fused to a benzene ring" indefinite.

In response, appellant argues (Brief, page 8), "R must be a bivalent group. This is inherent in the definition of R." For the reasons provided by the examiner we are not persuaded by this argument.

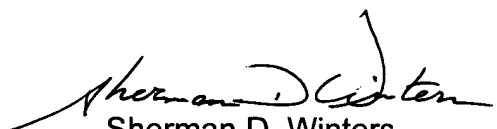
In addition, appellant continues (Brief, page 8) by combining the first definition of R – "R is H, alkyl, alkenyl, aryl-(CH₂)_p-, heteroaryl-(CH₂)_p-, cycloheteroalkyl-(CH₂)_p -," – with the alternative definition of R – "R can be joined together with the carbon to which it is attached to form a 3 to 7 membered ring which may optionally be fused to a benzene ring" – arguing (id.), "[t]he ring thus can be formed with any of the above R groups which will give a 3 to 7-membered ring." However, as the examiner explains, "[t]he second alternative for R doesn't


say that it is made from a piece of the first alternative for R. It is just a brand new alternative. Appellants, in an attempt to make the claim seem definite, are reading into the claim something that isn't there." We agree.

Accordingly, we affirm the examiner's rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as indefinite. As set forth supra, claims 6, 7 and 12-14 will fall together with claim 1.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


Sherman D. Winters
Administrative Patent Judge


Donald E. Adams
Administrative Patent Judge


Eric Grimes
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
)
) APPEALS AND
)
) INTERFERENCES
)
)
)

Appeal No. 2001-158
Application No. 08/833,172

Page 7

Burton Rodney
Bristol-Myers Squibb Company
P.O. Box 4000
Princeton, NJ 08543-4000

DEA/jlb